

From: jcullem@cellsignal.com
Sent: Tuesday, June 10, 2003 12:10 PM
To: Unity Comments
Subject: COMMENTS ON UNITY OF INVENTION STANDARD

in response to an invitation (in the PTC Journal of May 23rd (Vol. 66)) to provide comment on the USPTO's consideration of adopting a Unity of Invention standard vs. the present Restriction practice, my opinions on each specific question are:

1. while I am whole-hearted in support of the USPTO adopting an EU style Unity of Invention standard to replace the present restriction practice, I don't believe it should adopt a one independent claim per category strict standard: such a strict rule would be in opposition to the ability of the patentee to be their own lexicographer and present claims to their subject matter of varying scope; this is particularly now important in view of the Festo decisions; perhaps a better rule would be to cap independent claims at 5 per application, regardless of category (with no more than 3 in a given category); examination should certainly emphasize the independent claims, but dependent claims should be given due consideration as well, as they may be patentable whereas the independent claims are not;
2. I like the concept of being able to pay to keep an additional invention that lacks unity in one application (although 35 USC Sec. 101 limits on "an" invention would seem to necessitate that truly independent inventions be pursued in a separate app); I don't believe any change should be made to patent term extension under 35 USC Sec. 154 regarding applications including such additional inventions; IF the PTO expects delays in examination of applications based on such additional claim inclusion which would contravene the time limits set out in Sec. 154, perhaps the PTO should adopt a "priority" divisional application practice, where the additional inventions can be immediately divided out and the new divisional will be marked "priority" and examined alongside the parent application (thus avoiding big time delays for the applicant)
3. the applicant should be allowed to elect an invention to be examined if lack of unity exists;
4. the PTO should only conduct a "partial" search if lack of unity is found, else it should do a full search; if lack of unity is found, search should be conducted on the invention elected by the applicant;
5. the PTO should not make any fee increase pertaining to costs of examination under a Unity standard; it should work towards eliminating fee diversion by the government, in which case any "increase" in exam costs

would be paid for; in my opinion, I don't believe that any real increase in examination cost will in fact result from the Unity standard vs. the current Restriction standard (the latter is very time consuming and often results in multiple papers and calls between Examiner and applicant trying to avoid undue restriction requirements made by Examiners); moreover, a Unity standard will probably decrease work and cost since fewer unnecessary divisionals will need to be filed, saving everyone, including the PTO, time and money;

6. I leave to the PTO to figure out how work should be assigned to ensure "quality of work" does not suffer under a Unity standard; I will note, however, that in my opinion, the present quality under the restriction standard is poor: Examiners often don't seem to apply a "common sense" approach in really trying to understand the disclosed invention broadly, and take an open-minded and fair approach to the applicant's attempts to set out claims of varying language and scope to fairly define their invention; rather, Examiners often seem to quickly look for a "hook" on which to issue a restriction and avoiding doing any work: the "hook" is often the so called "undue and multiple" searches, which are often asserted but unsupported and made even though same class and subclass subject matter is found; Unity would be a real breath of fresh air that would improve quality and ensure that the Examiners, and thus the PTO, do not act inimically to the patent laws' mandate that an applicant should be able to define their invention in varying language and scope and keep different embodiments of the same inventive subject matter in one application;

7. no, I don't think restriction should be maintained alongside option Unity standard; the latter should wholly replace the former, including w/ necessary statutory changes - but could be implemented as an optional standard in advance of the statutory changes; the sooner, the better

8. no, I don't think the PTO should utilize the RCE as a mechanism for applicants to attempt to keep in prosecution that which was improperly and unfairly restricted out in the first place, because this will simply become a cash-cow mechanism for the PTO: Examiners will continue to routinely issue knee-jerk restriction requirements, applicants will pay yet another RCE fee that they should not need to, and it is unlikely that an Examiner who maintained a restriction in the first place is going to change his/her mind simply because an RCE and fee was filed and paid; a better solution is to get rid of the present restriction system;

9. the PTO should seek statutory change to 35 USC Sec. 121 to adopt Unity and dump the present restriction practice;

final comment: the present restriction practice is real problem and drain

in the biotech arts, where very often a single application discloses and fairly claims product, method of production, and methods of use, including genus and preferred species claims; in my experience, almost always Examiners issue knee-jerk restrictions, almost as though a filing receipt was being issued, as a necessary part of prosecution; I believe this stems from a poor understanding of when restriction SHOULD be made and when it should NOT, and from a poor understanding of applicant's entitlement to keep in one application varying related claim drawn to differing aspects of the SAME invention disclosed in one application; perhaps in the meanwhile, if and while the PTO is pursuing adoption of a Unity standard, it can require all Examiners to attend update education seminars on restriction practice that focus on the this theme: restrictions should not be made unless really necessary and examiners should endeavor to understand the claims in view of the disclosure in its broadest sense, and strive to allow applicants to fairly maintain in one application claims to different embodiments of the same inventive subject matter;

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